

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration of this application in view of the present amendments and the following remarks. By this amendment, claims 1, 6, 8, 14, 15, 17-21, 24-26 and 45 are amended, and claims 5 and 51 are canceled. As a result, upon entry of this amendment claims 1-4 and 6-51 are pending in this case, with claims 1, 18, 27, 36 and 45 being independent claims, and claims 27-44 having been previously withdrawn from prosecution in response to a restriction requirement. Because no claims are added by this amendment, it is believed that no fees in addition to the fee for a one-month extension of time are due for the consideration of this paper. However, if additional fees are due, the Commissioner is authorized to charge such fees to deposit account number 13-2855. A copy of this paper is enclosed.

Claim Amendments

Claim 1 is amended to more clearly recite that the game figure character has a mechanically functional combat component that is moveable with respect to the base of the game figure character and is configured to physically engage other action figure game pieces in simulated battles. Claims 18 and 45 are also amended in a similar manner. The amendments to claims 1, 18 and 45 are supported by the specification as originally filed at least at Figs. 1 and 2 and the accompanying text at pages 3-4, paragraph 25 describing the projectile 42 launched from the barrel 44, and at Figs. 8 and 9 and the accompanying text at page 4, paragraph 26 describing the spring-biased rotatable upper portion 12a of game piece 10'. Claim 6 is amended for consistency with the amendment to claim 1 to provide antecedent basis for the mechanically functional combat component.

Claims 8 and 24 are amended to more clearly recite that the game figure character has a first portion connected to the base and a second portion moveably connected to the first portion and biased toward a first position by a spring engaging the first and second portions. The second portion is configured to engage an adjacent game piece when the second portion moves from a second position to the first position under the biasing force of the spring. The amendments to claims 8 and 24 are supported by the specification as originally filed at least at Figs. 8 and 9 and the accompanying text at page 4, paragraph 26 describing the compressed

spring 49 returning the upper portion 12a to an equilibrium position, with a striking portion 48 of the upper portion 12a striking anything in its path.

Claim 14 is amended to more clearly recite that the limitations recited in claim 14 may comprise the device coupled to the axle of the game piece previously recited in claim 9. Claims 15 and 25 are amended to correct a typographical error by deleting “alternatively” and substituting “alternately.” Claims 17 and 19 are amended to correct a typographical error by removing an extraneous semicolon in the recitation of the wheel limitation. Claim 20 is also amended to depend from claim 19 to provide sufficient antecedent basis for the recitation of the pinion gear in subsequent claim 21. Claim 21 is amended to refer to the first surface of the circular rack as recited in the preceding limitation. Claim 25 is amended to depend from claim 21 to provide sufficient antecedent basis for the recitation of the rack in subsequent claim 26. Claim 26 is amended to more clearly recite that the second indicium is disposed on a second surface of the circular rack. This amendment to claim 26 is supported by the specification as originally filed at least at Figs. 2 and 9 and the accompanying text at pages 4-5, paragraph 27 describing the red marks 52 on the lower surface 30b of the rack 30 that may be visible through an aperture 58 of the second faceplate 56.

Applicants respectfully submit that the amendments to claims 1, 6, 8, 14, 15, 17-21, 24-26 and 45 do not present new matter and do not raise new issues, and respectfully requests entry of the present amendments to claims 1, 6, 8, 14, 15, 17-21, 24-26 and 45 and consideration of the claims as amended.

Claim Rejection Under 35 U.S.C. § 102(b)

Claims 1-3, 5, 6, 9-13, 15-22, 25, 26 and 45-51 were rejected under 35 U.S.C. § 102(b) as being anticipated by Potter (U.S. Patent No. 2,052,035). Applicants respectfully request reconsideration in view of the present amendments and respectfully submit that pending claims 1-3, 6, 9-13, 15-22, 25, 26 and 45-50 are not properly rejectable over the applied references for the following reasons. As discussed above, independent claims 1, 18 and 45 are amended to more clearly recite that the game figure character has a mechanically functional combat component that is moveable with respect to the base of the game figure character and is configured to physically engage other action figure game pieces in simulated

battles. Applicants respectfully submit that Potter fails to disclose or suggest a combat component as recited in independent claims 1, 18 and 45.

Potter teaches a table game having a field-board laid out as a combination football gridiron, baseball diamond, tennis court, polo field and track oval that may be used to play various games using pawns with scale devices for moving the pawns predetermined distances. A pawn may include a kicking device 253 allowing the pawn to punt or pass a ball during the football game, shoot the ball during a basketball, or project the ball in a manner corresponding actions by players in the various other disclosed athletic games. However, the kicking device 253 is not a mechanically functional combat component configured to physically engage other game pieces to simulate battles as recited in independent claims 1, 18 and 45. Potter does not disclose the kicking device 253 either engaging other pawns of the game directly, or projecting a ball at other pawns in a manner simulating battle with opposing pawns. In fact, Fig. 7 and the accompanying text of Potter teach away from engaging other pawns with a ball projected by the kicking device 253. In a football game, the quarterback pawn 216 with a kicking device projects a ball 215, 221 along a trajectory line 220 to a receiver pawn 217 and avoiding an offensive lineman pawn 214 and defensive pawn 218. In the other examples of athletic events, the ball is similarly projected in a manner intended to avoid engagement with opposing pawns in contrast to the mechanically functional combat component of the game pieces recited in claims 1, 18 and 45. Moreover, Potter does not provide any suggestion or motivation using the game board for simulated battles, or for using the kicking device 253 to engage other pawns at all, let alone in a manner simulating battle. Because Potter neither discloses nor suggests a game piece with a combat component configured to physically engage other game pieces to simulate battle, it follows that independent claims 1, 18 and 45 and the claims depending therefrom are neither anticipated nor rendered obvious by Potter.

In addition to the reasons discussed above, Applicants respectfully submit that many of the dependent claims are patentable over Potter for additional reasons. Claims 15-17, 25 and 26 recite a game piece having a display device alternately displaying and shielding indicium indicative of a special characteristic of the game piece. Potter does not disclose or suggest either special characteristic indicium for the game piece in addition to any

mechanism for measuring distance, or a device for alternately displaying and shielding such indicium. Potter discloses guide lines 240 and numerals 242 and 243 on the belt 239 functioning as distance indicators alternately viewable through the slot 232, but does not disclose or suggest any other indicia on the pawns either relating to any other characteristics of the pawns, or being alternately displayed. Additionally, Potter does not disclose or suggest a visual aperture in a faceplate for displaying the indicia as recited in claims 16 and 26, or indicia being disposed on a second surface of a rack on which distance indication indicia is disposed. Even if the belt 239 is considered to be a rack, a point which Applicants do not concede, Potter discloses indicia for measuring distance on the belt 239 disposed on the outwardly-facing surface, but does not disclose any other indicia on either surface of the belt 239.

Claim 17 recites further limitations not found in Potter, including a wheel and a pinion gear fixedly secured to an axle, with the pinion gear being engaged by a circular rack. The Examiner asserts that the lower cylinder 237 is the wheel, that the upper cylinder 235 is a pinion, and that the belt 239 is a rack. The cylinders 235, 237 and belt 239 do not satisfy the recited limitations for at least several reasons. First, the cylinders 235, 237 are mounted on pivot pins 234, 236, respectively, and not fixedly secured to the same axle as recited for the wheel and the pinion gear of claim 17. Second, the cylinder 235 does not include a plurality of teeth as recited for the pinion gear of claim 17. Third, as discussed above, the belt 239 is disclosed as having distance measurement indicia in the form of guide lines 240 and numerals 242, 243 disposed thereon, but there is no disclosure of any other indicia, let alone special characteristic indicia, being disposed thereon. Finally, Potter offers no suggestion or motivation for replacing the mechanism consisting of the cylinders 235, 237 and belt 239 for alternately displaying the numerals 242, 243 disposed on the belt with a gear-driven mechanism as recited in the claim. As the cylinder 237 rolls over the playing surface, the belt 239 is driven by the cylinder 237 to roll over the upper cylinder 235 with the guidelines 240 and numerals 242, 243 alternately passing the slot 232. One skilled in the art would not be motivated to replace this simple drive mechanism with a set of gears. Due to the use of the belt 239, additional gears are unnecessary to drive the upper cylinder 235 to pull the belt 239 past the slot 232. Moreover, reconfiguring the cylinders 235, 237 with teeth and adding additional gears between the cylinders 235, 237 would unnecessarily increase the cost and

complexity of an otherwise simple and inexpensive toy. Therefore, for at least these additional reasons, Potter does not anticipate or render obvious claims 15-17, 25 and 26.

Claim Rejections Under 35 U.S.C. § 103

Claims 4 and 14 were rejected under 35 U.S.C. § 103(a) as being obvious over Potter, and claims 7, 8, 23 and 24 were rejected under 35 U.S.C. § 103(a) as being obvious over Potter in view of Andrews *et al.* (U.S. Publication No. 2003/0220044 A1). Applicants respectfully request reconsideration and withdrawal of the rejections. Initially, claims 4 and 14 depend from claim 1, and it is respectfully submitted that claims 4 and 14 are not anticipated or rendered obvious by Potter for the reasons discussed above. Claim 4 recites that the distance measuring device provides both a visual and an audible indication of the distance. As the Examiner points out, Potter discloses one embodiment of a pawn with a visual indicator of distance, and a second embodiment of a pawn with an audible indicator of distance. However, Potter provides no suggestion or motivation for combining the embodiments in a single pawn having both visual and audible indications of distance. The Examiner asserts that a person skilled in the art would be motivated to combine the embodiments to allow a visually challenged person to play the game, but the Examiner does not point to any teaching in Potter or any other prior art reference of a game piece providing both an audible and a visual indication of distance. The only suggestion of such a combination is provided in Applicants' own disclosure, the use of which constitutes impermissible hindsight analysis. *Orthopedic Equipment Co. v. United States*, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983) (It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.). It is clear that the prior art must make a suggestion of or provide an incentive for the claimed combination of elements for the examiner to be able to establish a *prima facie* case of obviousness. See, *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). Because Potter fails to disclose or suggest combining the audible and visual pawn embodiments in a single pawn, and the Examiner has not cited any other reference providing a suggestion or motivation for such a combination, it follows that Potter cannot render claim 4 obvious.

Claim 14 recites similar limitations as previously-discussed claim 17 of a pinion gear with a plurality of teeth fixedly secured to the same axle as the wheel, and a circular rack engaging the pinion gear. Applicants respectfully submit that claim 14 is also patentable over Potter for the same reasons as discussed above for claim 17. The Examiner asserts that it would have been obvious to modify the pawns of Potter to use gears with gear teeth because use of gearing in the amusement arts is commonly known. Applicants respectfully submit that common knowledge and use of alternative structures does not satisfy the requirement of a suggestion or motivation for combining references or modifying a reference to arrive at the claimed invention. The mere fact that references *can* be modified is *not* sufficient to establish a *prima facie* case of obviousness. See Section 2143.01 of the M.P.E.P., which states: “The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)” (emphasis original). Because the Examiner has not identified a suggestion or motivation in the prior art for the proposed modification, it follows that Potter alone does not render claim 14 obvious.

Claims 7 and 23 recite that the mechanically functional battle component of the game piece is a spring-loaded projectile launcher. As discussed above, the prior art must make some suggestion or provide motivation for the proposed combination of references. The Examiner uses Andrews *et al.* for the teaching of spring-loaded projectile launchers in toys, but does not identify any suggestion or motivation in either Andrews *et al.* or Potter for combining the references. Instead, the Examiner states in conclusory fashion that such launchers simulate real weapons and attract people, and therefore one of ordinary skill in the art “would have suggested” providing such a launcher with the pawns of Potter. Potter teaches a game board and pawns for use on playing various sports, none of which uses “weapons” and, therefore, provides no suggestion or motivation to substitute simulated weapons for the kicking devices 253. Moreover, the Examiner provides no support for the assertion that spring-loaded projectile launchers attract people, and would attract additional people to play the various sports disclosed in Potter such that a person skilled in the art would be motivated to combine the references. Finally, the Examiner suggests that the person skilled in the art would have suggested the combination. In order to establish a *prima facie* case of obviousness, it is not the person of ordinary skill in the art that must suggest the

claimed combination, but the prior art itself that must provide the necessary motivation or suggestion to combine the references. Because the prior art fails to suggest adding a simulated weapon to a sports game pawn in the manner proposed by the Examiner, it follows that claims 7 and 23 are not rendered obvious by the Potter and Andrews *et al.* references.

Claims 8 and 24 as amended recite that the combat component includes a second portion of the game figure character moveably connected to a first portion of the character mounted to the base, and a spring engaging the portions and biasing the second portion to engage an adjacent game piece. Potter does not disclose or suggest providing a spring for the pawns and, as discussed above, does not disclose pawns having battle components for engaging adjacent pawns. Andrews *et al.* discloses spring-loaded projectile launchers, but does not disclose the toy figure 10 having a portion of the toy figure biased by a spring to engage adjacent toy figures. A lower torso 12 and an upper torso 20 of the toy figure 10 are joined in a pivotal motor driven attachment to allow the upper torso to be rotated by the motor to aim the weapon launchers. Andrews *et al.* does not suggest replacing the motor with a spring engaging the lower and upper torsos 12, 20, respectively, and does not suggest having any portion of the toy figure 10 engage other toy figures to simulate battle as recited in claims 8 and 24. For these reasons, the Potter and Andrews *et al.* references do not disclose or suggest combat components as recited in claims 8 and 24 and, consequently, do not render claims 8 and 24 obvious.

For at least the foregoing reasons, reconsideration and withdrawal of the rejection of the claims and allowance of the currently pending claims are respectfully requested. Should the Examiner wish to discuss the foregoing or any matter of form in an effort to advance this application towards allowance, she is urged to telephone the undersigned at the indicated number.

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